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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,227	02/19/2004	Charles Edward Akers JR.	2003-0701.01	5201

21972 7590 08/15/2006

LEXMARK INTERNATIONAL, INC.  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/782,227

Applicant(s)

AKERS ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-15.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Callie E. Shosho  
Primary Examiner  
Art Unit: 1714

**Attachment to Advisory Action**

1. Applicant's amendment filed 8/4/06 has been fully considered, however, the amendment has not been entered given that the amendment raises new issues that would require further consideration. The amendment raises new issues under 35 USC 112, first paragraph.

Specifically, claim 10 has been amended to recite that the ink comprises "4 percent to about 4.5 percent color pigment having aromatic rings wherein said color pigment is magenta pigment or yellow pigment". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112 first paragraph since there does not appear to be a written description requirement of the above phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

While Table 1 provides support for 4.5% magenta pigment, i.e. Pigment Red 122, and 4.5% yellow pigment, i.e. Pigment Yellow 74, there is no support to recite that the color pigment is present in amount of "about" 4.5 percent. It is noted that Table 1 discloses ink comprising 4.5% magenta pigment or yellow pigment and thus, provides support for the recitation of "4.5 percent". However, the Table does not provide support for the recitation of "about" 4.5 percent that includes amounts slightly above and below 4.5 percent for which there is no support in the specification as originally filed.

Further, it is noted that even *if* the amendment were entered, the present claims would not be allowable over all the cited prior art.

If entered, applicants' amendment would overcome the 35 USC 102 rejections of record with respect to Sun et al. (U.S. 2004/0127619) and Sacoto et al. (U.S. 2004/0102541) as well as the 35 USC 102/103 rejection of record with respect to Akers, Jr. et al. (U.S. 6,652,634).

However, the amendment would not overcome the rejection of claims 10-11 and 13-14 under 35 USC 103 utilizing Akers, Jr. et al. (U.S. 6,652,634).

Applicants argue that given that Akers, Jr. et al. is available as prior art under 35 USC 102(e), given that Akers, Jr. et al. is utilized in a rejection under 35 USC 103, and given applicants statement of common ownership, Akers, Jr. et al. is no longer applicable against the present claims.

However, firstly, it is noted that applicants have attempted to disqualify Akers, Jr. et al. under 35 U.S.C. 103(c) by showing that the present invention was owned by, or subject to an obligation of assignment to, the same entity as Akers, Jr. et al. at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, Akers, Jr. et al. is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(l).

While applicants state that Akers, Jr. et al. and the present invention have a common assignee, namely, Lexmark International, Inc., applicants have not provided a proper statement indicating common ownership or assignment at the time the invention was made.

Further, even if applicants were to provide proper evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Akers,

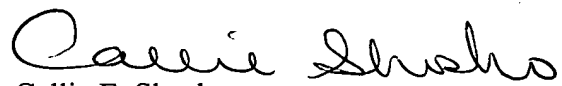
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Jr. et al. at the time this invention was made, or was subject to a joint research agreement at the time this invention was made, it is noted that Akers, Jr. et al. additionally qualifies as prior art under another subsection of 35 U.S.C. 102, namely, 35 USC 102 (a), and therefore, would not be disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

As set forth in MPEP 706.02(1)(3), a commonly owned reference is only disqualified as prior art when (A) proper evidence is filed, (B) the reference *only* qualifies as prior art under 35 USC 102 (e), (f), or (g) (e.g. not USC 102(a) or (b)) and (C) the reference was used in an obviousness rejection under 35 USC 103(a). However, applicants have not met requirement (A) as set forth above and given that the present application was filed 2/19/04 and given that the publication date of Akers, Jr. et al. is 11/25/03, applicants have also not met requirement (B) given that Akers, Jr. et al. is also available as prior art under 35 USC 102(a).

Thus, if the amendment were entered, Akers, Jr. et al. would not be disqualified as prior art under 35 USC 103(a) and would remain a relevant reference against claims 10-11 and 13-14.

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
8/11/06